

Remarks

In the Office Action mailed 03/08/2006, Claims 1-7 are pending in the application. Claim 6 has been amended.

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Claims 1-7 are rejected under 35 USC 101.

Claims 1, 2, 3, 6, and 7 are rejected under 35 USC 102(e) as being anticipated by Ewing (US 20030167135).

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Claims 4 and 5 are rejected under 35 USC 103(e) as being unpatentable over Ewing in view of Kondo (US 4,181,715).

Rejections Under 35 U.S.C. § 101

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Claims 1 - 7 are rejected under 35 USC § 101. This rejection is respectfully traversed.

35 U.S.C. § 101 provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." M.P.E.P. § 2106.IV.A. explains:

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As cast, 35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" while the first category defines "actions" ..... See 35 U.S.C. 100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine manufacture, composition of matter, or material.").

Thus, a process is recognized specifically by 35 U.S.C. § 101 as appropriate subject matter of a patent. Further, a number of Safe Harbors exist that automatically establish a claimed process as statutory subject matter. For example, the Pre-

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Computer Process Activity Safe Harbor makes a process statutory if it requires measurements of physical objects or activities to be transformed outside of the computer into computer data. M.P.E.P. § 2106.IV.B.2.(b).

To reject a claim under 35 U.S.C. § 101, the M.P.E.P requires that an  
5 Examiner establish a *prima facie* case for each claim, showing that the claimed invention as a whole is directed solely to an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when a claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101, and when such a rejection is made, Office personnel must  
10 expressly state how the language of the claims has been interpreted to support the rejection. Only one practical application is necessary to satisfy the utility requirement. M.P.E.P. § 2106.II.A.

Applicant respectfully asserts that the language of the claims clearly state  
15 patentable subject matter. Independent Claim 1 claims a method for selecting a tester design from one or more design alternatives. This method is patentable subject matter under 101. Independent Claim 6 clearly claims a computer readable medium, also appropriate subject matter for a patent.

20 Accordingly, Applicant requests withdrawal of the 35 U.S.C. § 101 rejection of the claim 16 and asserts that claims 1 through 7 are patentable.

#### REJECTIONS UNDER 35 U.S.C. § 102

25 Claims 1, 2, 3, 6 and 7 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ewing (US 20030167135). This rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single  
30 reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

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Applicant respectfully submits that Ewing does not teach (expressly or inherently) at least the following features Ewing in independent Claim 1: constructing Operating Characteristics curves for each classifier, and selecting a design alternative based on the Operating Characteristics curves. The "model" of Ewing predicts biological or other activity by using transformed descriptor values. The descriptors are transformed via transformation functions that convert the raw descriptor values to new values ... In other words, the models are comprised of one or more descriptor transformation functions. (Ewing para 0016). Thus, a model in Ewing is a mathematical expression which transforms the input variables into an output value. In great distinction, an Operating Characteristics curve is the mathematical characterization of the false identification rates of the underlying classifier that include false positive and false negative (escape) rates. The model of Ewing is not the equivalent of the Operating Characteristics curve of Applicant's invention. Ewing does not teach or suggest using Operating Characteristic curves. The rejection with respect to Claim 1, and dependent claims 2 and 3 which depend on Claim 1, should be withdrawn.

Similarly with respect to Claims 6 and 7, Ewing does not teach the construction of Operating Characteristics curves for each classifier; the model described in Ewing is not the equivalent of Applicant's Operating Characteristics curves. The rejection should be withdrawn.

#### 35 U.S.C. § 103 - OBVIOUSNESS

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Claims 4 and 5 are rejected under 35 USC 103(e) as being unpatentable over Ewing in view of Kondo (US 4,181,715). This rejection is respectfully traversed.

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To

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establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable  
5 expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

10 When a proposed modification or combination of the prior art would render the prior art invention unsatisfactory for its intended purpose or change the principle of operation of the prior art invention, there is no suggestion or motivation to make the proposed modification. As a result, the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01.

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As discussed above, Ewing does not teach the use of Operating Characteristics curves. Neither Ewing nor Kondo teach or suggest using factorial design in combination with the use of Operating Characteristics curves. The rejection should be withdrawn.

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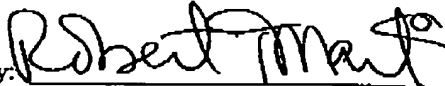
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Conclusion

In view of the above, Applicant believes the pending application is in  
5 condition for allowance.

Respectfully Submitted,

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